REMARKS

Claims 1-20 are pending in the application. The Office action asserts the claims do not meet the requirements of patentability under 35 U.S.C. §103(a) as being unpatentable over Behfar et al. (WO 00/77620, "Behfar") in view of Trebes Jr. (US 6,317,438, "Trebes"). Applicants traverse this contention and request reconsideration.

In the instant Office action, it is asserted that the combination of Behfar in view of Trebes renders unpatentable the pending claims. Since both Behfar and Trebes fail to teach or suggest a vehicle incorporating an active network structure, the asserted combination cannot render the claims unpatentable.

To establish a prima facie case of obviousness, and hence to find claims 1-20 unpatentable under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based upon applicant's disclosure. MPEP at § 2142.

The mere fact that references can be modified is not sufficient to establish a prima facie case of obviousness. *See* Section 2143.01 of the MPEP, which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." (emphasis added) The suggestion to combine references must be from the prior art, not the Applicants' disclosure. *See* Section 2143 of the MPEP, which states: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

To demonstrate this principles for rejecting a claim under 35 U.S.C. § 103, the applicants point to In re Rouffet, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) wherein the Federal Circuit explained:

> To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.

Id. at 1455 (citations omitted and emphasis added). In the Rouffet case, the examiner had rejected the pending claims on a combination of references. The Board sustained the examiner. However, the Federal Circuit reversed the Board's decision and ruled that the examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the examiner.

As explained by the Federal Circuit:

> As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to **show a motivation to combine the** references that create the case of obviousness.

Id. at 1457 (citations omitted and emphasis added). These principles have not been followed in rejecting the pending claims. Merely stating an advantage of the combination, as was done to reject the pending claims, is not the same as "show[ing] a motivation to combine the references."

On the contrary, in order to establish a prima facie case of obviousness, there must be <u>actual evidence</u> of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be <u>clear and particular</u>. <u>In re Dembiczak</u>, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a prima facie case of unpatentability, particular factual findings demonstrating the suggestion to combine must be made. See, for example, <u>Ecolochem Inc. v. Southern California Edison</u>, 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000) and <u>In re Dembiczak</u>, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999).

The proffered combination of Behfar in view of Trebes fails to meet at least one of the criteria for establishing a prima facie case of obviousness.

There is no suggestion or motivation in the references to combine them to achieve the applicants' claimed invention. Whether or not either of the references teaches an active network architecture, the examiner admits that Behfar does not but asserts that such teaching may be found in Trebes, does not matter because there simply is no suggestion or motivation in either Behfar or Trebes to combine. In making such a rejection, it is the examiner that has the duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967); MPEP 2142.

Here the applicants have combined known architectures, a vehicle and an active network. The applicants do not attempt to claim an active network *per se* or an active network in a telecommunications system, as taught by Trebes. Nor does the applicant attempt to claim a vehicle with any kind of network. Clear in the pending claims, the applicants claim a vehicle that includes an active network structure. The structure of a vehicle in combination with an active network is not taught or suggested in the art.

More particularly, Trebes describes an active network structure in a telecommunications system. There is no teaching or suggestion whatsoever that the described network structure could be implemented in a vehicle environment. Thus, to establish a prima facie case of obviousness, the suggestion or motivation must come from

Behfar. However, Behfar also fails to offer any such suggestion or motivation to incorporate an active network structure, and more likely teaches away from such a combination. Behfar addresses the problem within a vehicle of adapting new devices to the vehicle after it has been designed or placed into service. It is not addressed to issues of how the communication between the devices occurs within the network, but as mentioned, only as to how new devices are added to the network. In this regard, Behfar teaches an approach wherein each device is coupled to a vehicle network structure. Behfar does not suggest that a problem or need exists relating to being able to transfer data with a capacity for data path redundancy, i.e., multiple communication paths between devices, nor could it offer any such suggestion. Behfar is addressed solely to the problem of implementing new devices within the network.

As noted, if anything, Behfar teaches away. In the discussion wherein an "in-car sub-network" structure is described, perhaps suggesting that the network architecture may have multiple components or communication paths between devices, this discussion is directed entirely to coupling the in-vehicle network to an external network such as the Internet. Thus, at best, Behfar teaches a multiple network component structure, i.e., the in-vehicle network coupled to the Internet, but such a structure is not the claimed active network with a data path redundancy capability within the active network. Behfar teaches away from such a structure incorporating redundancy internally to the active network, opting instead for a combined, almost on a peer-to-peer basis, of two independent network entities. For these reasons, one of ordinary skill in the art would not be motivated to combine Behfar with Trebes in order to provide the claimed invention. As such, the examiner has failed to establish a prima facie case of obviousness, and claims 1-20 are allowable.

For at least these reasons, the applicants submit claims 1-20 are allowable, and such action is respectfully requested.

If there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

Dated: August 12, 2004   Respectfully submitted,

                                           By
                                           Anthony G. Sitko
                                              Registration No.: 36,278
                                           MARSHALL, GERSTEIN & BORUN LLP
                                           233 S. Wacker Drive, Suite 6300
                                           Sears Tower
                                           Chicago, Illinois 60606-6357
                                           (312) 474-6300
                                           Attorney for Applicant